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JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET ATLANTA, GA 30309			EXAMINER BLECK, CAROLYN M	
			ART UNIT 3626	PAPER NUMBER

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/577,101

Applicant(s)

HANBY ET AL.

Examiner

Carolyn M Bleck

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4 May 2004 has been entered.
2. This communication is in response to the RCE filed 4 May 2004. Claims 19-39 are pending. Claims 19, 23, 25, 27-28, 31, 33, and 35-36 have been amended. Claims 1-18 have been cancelled.

Claim Rejections - 35 USC § 112

3. Claims 19, 31, and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. As per claims 19, 31, and 33, "policies" lacks proper antecedent basis. For example, note the use of "policies" at claim 19, step C(i)(a-c), claim 31 step D and step D(i)(a-c), and claim 33 step D. The Examiner respectfully submits that the Applicant refers to a single policy within these independent claims, and then later on begins referring to a plurality of policies. Appropriate correction or clarification is requested.

Dependent claims 20-30, 32, and 34-39 inherit the deficiencies of independent claims 19, 31, and 33, and are therefore rejected for the same reasons given for those claims, and incorporated herein.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 19-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

(A) For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 19 and 32 only recite an abstract idea. The recited steps including merely receiving and storing initial information in a database, processing the information to generate a proposal, and supplying renewal rates... do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to quote, issue, and administer group insurance.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention determines which policies need to be renewed (i.e., repeatable) used during the administration of group insurance (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention as a whole, is not within the technological arts as explained above, claims 19 and 31 are deemed to be directed to non-statutory subject matter.

(B) Similar analysis can be applied to dependent claims 20-24, 26, 29, 30, 32.

Therefore those claims are rejected for the same reasons as claims 19 and 31.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 19-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosco et al. (5,191,522) in view of Lockwood (4,567,359), Chapman et al. (6,526,386), and Official Notice.

(A) As per claim 19, Bosco discloses a method for storing, processing, and reporting information regarding a plurality of group insurance accounts using sales, underwriting, administration, and actuarial sub-systems (col. 28 lines 50-68) comprising:

(a) inputting and storing data concerning each group insurance account, including data on policyholders such as employers, unions, associations, and trustees, and address and industry type, coverage rate, participant restrictions, premiums, commissions, clients, claims, products, producers, payments, bills, provisions, obligation conditions, exposure fees, income, schedules, and reinsurance in a relational database, wherein the relational database comprises a case subject category comprising tables that contain data on a case description, activity history, coverage available, policy level, participants, coverage in-force, billing, producers, and commissions, and a coverage subject category comprising tables that contain data concerning rules and options of the insurance products marketed by the enterprise, coverage, services, and funding methods (col. 10 lines 9-18, col. 29 lines 38-42 and lines 53-60, and col. 31 lines 12-51);

(b) using the sales sub-system, comprised of specific stored program modules which are capable of inputting and processing data on the database, to process sales data to produce policyholder, coverage, rate, and participant data and to generate sales

proposals outlining the coverage, rates, and restrictions for an account, wherein means are provided for modifying and accessing sales data in the database (col. 3 lines 36-45, col. 30 lines 7-18);

(c) storing data related to the sales sub-system (col. 32 lines 40-47);

(d) generating certificates of insurance and participant identification cards using an administration sub-system comprising means for processing administration data, wherein the administration data includes account or case information, wherein case information includes all of the components of a plan of insurance for a client including the coverages included on a specific case, the case status, activity history, policy level, participants, coverage in force, billing, producers, and commissions (col. 6 line 22 to col. 7 line 69, col. 22 lines 13-31, col. 30 lines 32-59, col. 32 lines 15-19); and

(e) communicating, accessing, and modifying data stored in the database to administer the insurance policy (col. 29 lines 48-59) by:

(i) using a sales tracking program module to track data on renewals, cancellations, and additions to existing policies including tracking the case history with the insurer from initial contact, wherein at the conclusion of a policy period, accounting must be performed to determine the case's financial status, wherein reserve requirements are calculated and refunds become due, wherein the retrospective accounting program module automates the routine calculations that are necessary at the end of an accounting period for each case, wherein the module allows for alternate funding and monthly accounting minimum premium plans, wherein a prospective pricing program module performs the routine calculations necessary to determine premium

needs for a prospective policy period for each case, wherein the rates can be determined and updated as necessary (reads on "supplying a renewal rate") (col. 27 lines 10-40, col. 23 lines 30-45), wherein the following dates are tracked within the database, application date, case date, important processing dates, date of status per case, policy dates, accounting date (col. 6 lines 39-46 and lines 59-65, col. 7 lines 45-51 and lines 58-62, col. 8 lines 42-51, col. 25 lines 43-54).

Further, Bosco discloses communicating pertinent information to a client regarding coverage records, wherein at the conclusion of a policy period, the financial status of the case is determined and retention as well as reserve requirements are calculated and refunds are due, and wherein a prospective policy program module determines premium needs for a prospective policy period for each case and the rates can be determined and updated as necessary (col. 27 lines 10-40), wherein bills are generated at specified intervals for each account or account participant, and wherein payment of bills are recorded and validated (col. 30 lines 32-60).

Bosco fails to disclose receiving approval of the proposal.

Lockwood discloses a terminal for asking the customer if he or she wishes to make a purchase of an insurance quotation (col. 5 line 31 to col. 6 line 33).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the aforementioned feature within the method of Bosco with the motivation of verifying the customer wishes to purchase the insurance policy (Lockwood; col. 5 line 31 to col. 6 line 33).

Bosco fails to expressly disclose a master database and then loading information stored in the said master database into a renewal database comprising determining which policies in said master database feature an anniversary data that falls within a predetermined number of days from the date of said loading and storing information relating to said policies in said master database featuring said anniversary date to a renewal database. Further, Bosco fails to expressly disclose revising renewal status information for at least some of said policies whose information is stored in said renewal database, updating renewal status information for at least some of said policies whose information is stored in said renewal database, and updating said master database with information from said renewal database, relating to at least some of said list bill policies whose information is stored in said renewal database and at least some of said self bill policies whose information is stored in said renewal database.

Chapman includes automatically extracting data from a main database (reads on "master database") used for underwriting and claims handling for an insurance carrier to policy status database (reads on "renewal database") (see Fig. 1 and col. 3 line 50 to col. 4 line 37) to automatically flag at least one expiring policy stored on the central computer in the main database. Further, Chapman discloses a policy is considered to be expiring from the date on which it is determined that the policy is expiring through the date on which the policy is cancelled or officially determined to no longer be expiring, wherein a list of expiring policies is generated automatically by the system using a software interface running on the central computer to compare the cancellation date of each policy of insurance with the current date, wherein the cancellation date of each

policy of insurance is stored in a table in the "Expiration_Date" field, wherein a SQL query selecting one or more fields including the policy number field where the system date equals the Expiration_Date field (reads on "anniversary date" and "renewal date") will retrieve the data records relating to all expiring policies of insurance on which action must be taken, wherein a "Policy_Status" field is edited including renewal data such as the date on which the policy is renewed, and details regarding payments of premiums that are made, wherein an insurance carrier optionally verifies compliance with its underwriting standards in the case of a renewal policy (col. 3 lines 1-16, col. 4 lines 3-13, col. 5 line 13 to col. 6 line 67, col. 7 line 14 to col. 8 line 28).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Chapman within the method of Bosco with the motivation of providing substantial time and cost savings by reducing interaction with insurance personnel during the insurance renewal process (Chapman; col. 1 lines 23-28) by automatically flagging policies which need to be renewed.

Bosco, Lockwood, and Chapman fail to expressly disclose determining which of said policies whose information is stored in said renewal database are self bill policies, and for said self bill policies: determining if contribution meets a predetermined contribution level, and if not, checking to ensure that a census letter has been received, and if not, sending a census letter, if contribution meets the predetermined contribution level, checking to ensure that an eligibility letter has been received and if not, sending an eligibility letter, if said eligibility letter has been received, determining whether participation meets a predetermined participation level, and if not, printing a

participation letter; for said policies whose information is stored in said renewal database which are list bill policies: determining if contribution meets a predetermined contribution level and if not checking to ensure that an eligibility letter has been received and if not, sending an eligibility letter, and if said eligibility letter has been received, determining whether participation meets a predetermined participation level, and if not, printing a participation level.

However, Bosco discloses different types of processing for a list bill using a list billing module and a self-administered bill using a self-administered billing program module (col. 24 line 32 to col. 25 line 54).

Further, Official Notice is taken that it well known in the insurance processing industry that different types of policies are processed in different ways. Further, Official Notice is taken that it is well known in the art that letters, such as a census letter, eligibility letter, participation letter, etc. are sent to clients based on whether or not the client needs to receive the letter.

At the time the invention was made, it would have been obvious to include the feature of determining a type of policy and sending a letter to a client based on specific criteria within the method of Bosco, Lockwood, and Chapman with the motivation of providing an efficient way to support new product development, administration, and regulatory reporting requirements of the insurance industry (Bosco; col. 1 line 63 to col. 2 line 5).

The Examiner also notes that claim 19 recites an "if-then" statement (i.e., if self bill, perform certain steps; if list bill, perform certain steps.) It is unclear to the Examiner

whether there are only two categories, namely list bill and self bill. If there are more than two categories, the Examiner respectfully submits that neither of the steps within claim 19 referring to list bill or self bill policies and the generation of letters are required to occur. Clarification is requested from the Applicant regarding this issue.

In addition, insofar as Applicant recites "at least some of the following...", it is irrelevant whether or not Bosco, Lockwood, or Chapman disclose every single parameter recited in the claim.

(B) As per claim 20, Lockwood discloses asking the customer if he or she wishes to make a purchase of an insurance quotation (col. 5 line 31 to col. 6 line 33).

(C) As per claim 21, Bosco discloses processing underwriting data comprising case tracking means for tracking and logging tasks associated with each account after sale (col. 30 lines 18-31). It is noted that Bosco's "processing underwriting data after the sale of an insurance policy", would include "receiving approval... from the insurance company" because the policy would have to be agreed to by the insurance company prior to being issued.

(D) As per claim 22, Bosco discloses communicating pertinent information to a client regarding coverage records, wherein at the conclusion of a policy period, the financial status of the case is determined and retention as well as reserve requirements are calculated and refunds are due, and wherein a prospective policy program module

determines premium needs for a prospective policy period for each case and the rates can be determined and updated as necessary (col. 27 lines 10-40), wherein bills are generated at specified intervals for each account or account participant, and wherein payment of bills are recorded and validated (col. 30 lines 32-60).

It is respectfully submitted that Bosco discloses determining the financial status of a case and the rates for that case at the conclusion of a policy and then generates a bill for that account. Furthermore, it is noted that when a customer pays a bill, the customer receives coverage under an insurance policy, and also accepts the policy by paying the bill. If the customer did not pay the bill, the customer would not receive coverage, and would not be accepting the rate. Therefore, it is respectfully submitted that a client's payment of the bill constitutes approval of a rate. The skilled artisan would have found this an obvious modification within the method taught collectively by Bosco, Lockwood, and Chapman with the motivation being to ensure a customer agrees to a new insurance rate at the end of a policy.

(E) As per claims 23-24, Bosco discloses:

(a) providing a direct feed of data regarding rates to the billing modules (col. 24 lines 16-20);

(b) supporting various list bill applications by creating, storing, and maintaining detailed records on an individual's coverage selections, benefit levels, and status (col. 24 lines 20-30);

(c) generating premium statements for policy holders using a self-administered billing module, wherein the bills are generated on a stated frequency or specified interval (reads on "billing date") which reflects the coverage, bill mode, bill categories, rate structure, and bill location, wherein the bills report census, payroll, and premium data including any prior adjustments (col. 24 lines 50-61 and col. 30 lines 32-60);

(d) wherein billing data is stored in a table format of a database, wherein each policy is associated with a bill, wherein a bill entity within the database is a request for payment of contractual amounts due for services and/ or insurance, wherein the entity identifies the billee (client and/or covered person) and includes a system assigned bill number (col. 2 lines 52-60, col. 5 lines 52-65, col. 6 lines 47-57); and

(e) wherein a policy bill entity exists in the database which identifies the specific policy for which a bill has been generated for the collection of monies due, wherein this entity reflects the fact that more than one bill may be required to collect money under a single policy (i.e., multiple coverages grouped under one policy but billed separately), and wherein a bill may also represent money due on more than one policy (col. 8 lines 52-58).

Bosco is entirely silent as to the function of if a previous bill having the same billing data has been issued, then generating a duplicate of the previous bill. However, it is respectfully submitted that a billing system would typically generate a duplicate of a bill if that bill not been paid, and the skilled artisan would have found it an obvious modification to include generating a duplicate bill within the method taught collectively Bosco, Lockwood, and Chapman with the motivation of increasing the efficiency and

reducing the time to generate bills (Bosco; col. 2 lines 39-45) thus ensuring an insurance company is paid by customers for insurance coverage.

The remainder of claim 23 repeats the same limitations as claim 19, and is therefore rejected for the same reasons given for claim 19, and incorporated herein.

(F) As per claim 25-27, Bosco discloses:

(a) a collection module for receiving payment for products and services renders, wherein the collection module accepts, validates, and records monies collected, wherein payments can be collected directly by wire transfer (col. 25 lines 25-32, col. 30 lines 32-59);

(b) a reconciliation program module for collecting premium, fee, or income payments, wherein the reconciliation program reconciles monies at the client level, and wherein premium and service fee payments are internally tabulated to verify that the paid amount by the client balances to that reported or billed less any adjustments and any outstanding balance is noted by the system (col. 25 lines 33-42);

(c) a premium allocation program module to process payments to the correct line of business and coverage type, wherein the premium allocation is internally performed according to the amount of premium paid, coverage type, accounting date, rating method, and census input (col. 25 lines 43-54); and

(d) a commission fee payment program module to create and maintain producer records and schedules, to calculate commission and fee payments (based on a specific schedule), and to provide the producer with a detailed accounting of transactions,

wherein the commission schedule is applicable to a funding method, wherein the commissions are calculated based on those due on each account (col. 19 lines 26-30, col. 25 lines 55-63, col. 30 lines 32-59).

The remainder of claims 25-27 repeats the same limitations as claim 19, and is therefore rejected for the same reasons given for claim 19, and incorporated herein.

(G) As per claim 28, Bosco discloses:

(a) using an automated correspondence program module to communicate and distribute mailings and coverage records, wherein the module can identify those to whom statutory, product, legislative, and other insurance information should be conveyed, and then selectively disseminating the desired correspondence (col. 27 lines 29-40);

(b) using a proposals module to generate proposals outlining the coverages, rates, and restrictions of the insurer's quote (col. 24 lines 3-8);

(c) generating reports for notifying personnel of tasks to be performed (col. 30 lines 18-31);

(d) using a financial reporting means for providing premium and claim information (col. 30 lines 60-69); and

(e) wherein data is transferred between modules and with the relational database (col. 21 line 50 to col. 22 line 7).

The remainder of claim 28 repeats the same limitations as claim 19, and is therefore rejected for the same reasons given for claim 19, and incorporated herein.

(H) As per claims 29-30, Bosco discloses determining and updating rates as is necessary using a prospective pricing program module to perform the routine calculations (col. 27 lines 22-28). The remainder of claims 29-30 were addressed above in the rejection of claim 19, and incorporated herein.

(I) As per claim 31, Bosco discloses a method for storing, processing, and reporting information regarding a plurality of group insurance accounts using sales, underwriting, administration, and actuarial sub-systems (col. 28 lines 50-68) comprising:

(a) inputting and storing data concerning each group insurance account, including data on policyholders such as employers, unions, associations, and trustees, and address and industry type, coverage rate, participant restrictions, premiums, commissions, clients, claims, products, producers, payments, bills, provisions, obligation conditions, exposure fees, income, schedules, and reinsurance in a relational database, wherein the relational database comprises a case subject category comprising tables that contain data on a case description, activity history, coverage available, policy level, participants, coverage in-force, billing, producers, and commissions, and a coverage subject category comprising tables that contain data concerning rules and options of the insurance products marketed by the enterprise, coverage, services, and funding methods (col. 10 lines 9-18, col. 29 lines 38-42 and lines 53-60, and col. 31 lines 12-51);

(b) using the sales sub-system, comprised of specific stored program modules which are capable of inputting and processing data on the database, to process sales data to produce policyholder, coverage, rate, and participant data and to generate sales proposals outlining the coverage, rates, and restrictions for an account, wherein means are provided for modifying and accessing sales data in the database (col. 3 lines 36-45, col. 30 lines 7-18);

(c) storing data related to the sales sub-system (col. 32 lines 40-47);

(d) generating certificates of insurance and participant identification cards using an administration sub-system comprising means for processing administration data, wherein the administration data includes account or case information, wherein case information includes the all of the components of a plan of insurance for a client including the coverages included on a specific case, the case status, activity history, policy level, participants, coverage in force, billing, producers, and commissions (col. 6 line 22 to col. 7 line 69, col. 22 lines 13-31, col. 30 lines 32-59, col. 32 lines 15-19); and

(e) communicating, accessing, and modifying data stored in the database to administer the insurance policy (col. 29 lines 48-59) including producing individual list bills and generating individual premium statements noting such variables as elected coverage, benefit levels, status, and premium due and using a billing program module (col. 25 lines 3-14); and

(f) wherein the stored program modules, such as the sales and billing program modules are capable of inputting and processing data onto the single relational

database (col. 3 lines 35-45), wherein all of the program modules are able to access the single database structure thus eliminating redundant data capture (col. 2 lines 5-25).

Bosco fails to disclose receiving approval of the proposal.

Lockwood discloses a terminal for asking the customer if he or she wishes to make a purchase of an insurance quotation (col. 5 line 31 to col. 6 line 33).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the aforementioned feature within the method of Bosco with the motivation of verifying the customer wishes to purchase the insurance policy (Lockwood; col. 5 line 31 to col. 6 line 33).

The remainder of claim 31 repeats the same limitations as claim 19, and is therefore rejected for the same reasons given for claim 19, and incorporated herein.

(J) As per claim 32, Bosco disclosed processing data including communicating with data storage means and means for accessing, capturing, and modifying sales, underwriting, administration, and actuarial data using program modules stored in sub-systems (col. 2 lines 5-25, col. 29 lines 1-44), wherein the modules include the Sales Tracking, Proposals, and Customer Support functional program modules shown in FIG. 11, wherein the proposal module generates sales proposals, the Case Tracking, Rating, and Field Bulletin functional program modules, the Case Management, Participant Records, Contract Certificate Issue, Estimated Bills, Self Administration Bills, List Bills, Individual Bills, Service Billing, Collection, Reconciliation, Premium Allocation, Commission Fee Payment, and Financial Reporting functional program

modules, wherein the list bills module accommodates billing for small group participants to reflect each participant's elected coverage, benefits, class, and premium due for that period, and the Experience Reporting, Reinsurance Management, Product Development, and Financial Reporting program modules (col. 22 lines 40-56, col. 24 lines 3-8 and 62-69).

In addition, insofar as Applicant recites "at least some of the following modules...", it is irrelevant whether or not Bosco or Lockwood disclose every single parameter recited in the claim.

The remainder of claim 32 repeats the same limitations as claim 19, and is therefore rejected for the same reasons given for claim 19, and incorporated herein.

(K) Claim 33 differs from method claim 1 by reciting system elements, namely, a user interface and a database. As per these elements, Bosco discloses:

(a) a plurality of workstations, each workstation comprising means for inputting data, means for displaying data, and means for selecting, accessing, and interacting with the memory means, wherein the means for displaying data is a data display screen (col. 23 lines 4-17 and col. 29 lines 38-42); and

(b) a database for storing data concerning a group insurance account (col. 28 lines 55-65).

The remainder of claim 33 repeats the same limitations as claim 19, and is therefore rejected for the same reasons given for claim 19, and incorporated herein.

(L) As per claim 34, Bosco discloses a printing means for producing printed standard contracts outlining policy provisions, conditions and obligations, and other provisions, and a printing means for producing printed individual participant certificates outlining selected coverage and conditions (col. 30 lines 31-59 and col. 31 line 10-11).

The remainder of claim 34 repeats the same limitations as claim 19, and is therefore rejected for the same reasons given for claim 19, and incorporated herein.

(M) As per claim 35, Bosco disclosed processing data including communicating with data storage means including the relational database and means for accessing, capturing, and modifying sales, underwriting, administration, and actuarial data using program modules stored in sub-systems (col. 2 lines 5-25, col. 28 lines 50-69, col. 29 lines 1-44), wherein the modules include the Sales Tracking, Proposals, and Customer Support functional program modules shown in FIG. 11, wherein the proposal module generates sales proposals, the Case Tracking, Rating, and Field Bulletin functional program modules, the Case Management, Participant Records, Contract Certificate Issue, Estimated Bills, Self Administration Bills, List Bills, Individual Bills, Service Billing, Collection, Reconciliation, Premium Allocation, Commission Fee Payment, and Financial Reporting functional program modules, wherein the list bills module accommodates billing for small group participants to reflect each participant's elected coverage, benefits, class, and premium due for that period, and the Experience Reporting, Reinsurance Management, Product Development, and Financial Reporting program modules (col. 22 lines 40-56, col. 24 lines 3-8 and 62-69).

In addition, insofar as Applicant recites "at least some of the following modules...", it is irrelevant whether or not Bosco, Lockwood, or Chapman disclose every single parameter recited in the claim.

The remainder of claim 35 repeats the same limitations as claim 19, and is therefore rejected for the same reasons given for claim 19, and incorporated herein.

(N) Claims 36-39 repeat the same limitations as claims 23, 25, and 27-28, and are therefore rejected for the same reasons given for those claims, and incorporated herein.

Affidavit

9. With respect to the affidavit filed 4 May 2004 alleging commercial success, the affidavit was carefully considered and deemed to be insufficient to overcome the rejections of the prior art for the following reasons:

(a) The declarations fail to establish a clear nexus between the alleged commercial success and the invention as claimed. The evidence is not commensurate in scope with the scope of the claims. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (1971). In particular, there is nothing that directly ties the statements given by, for example, Affiant Sandra Callahan, with the language specifically recited in the instant claims. For example, Affiant Sandra Callahan refers to "automated renewals of all policies" (item 11), "automation... is critical to the success of our group insurance lines" (item 12), "web-a-tized... processes to real time interact with any customer with any process" (item

13), "centralization of all our processes/data though our centralized database" (item 13), and "automation of pricing and renewing of our business automatically" (item 15).

However, nowhere in independent claims 19, 31, and 33 is there a specific recitation of an automated process or system, a web-a-tized process or system (i.e., using the Internet), or a centralized database. As such, it is noted that the specific features upon which the Affiant (and Applicant) relies as the reasons for commercial success are not recited in the instant claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, the courts have held that affidavits or declarations showing commercial success as secondary considerations of non-obviousness to the invention "described and claimed" or other equivalent indefinite language have little or no evidentiary value. *In re Troutman*, 1960 C.D. 308, 126 USPQ 56, 47 CCPA 308. In addition, statements which amount to an affirmation that the claimed subject matter functions as it was intended to function is not relevant to the issue of non-obviousness and provides no objective evidence thereof. See MPEP § 716.

As such, there is no clear and definite nexus between the statements averred by Sandra Callahan and Applicant's claims.

(b) In order to establish commercial success, the evidence must establish that the alleged commercial success is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles,

and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to Applicant or assignee, or other business events extraneous to the merits of the claimed invention. *In re Magneli et al.*, 176 USPQ 305 (CCPA 1973); *In re Noznick et al.*, 178 USPQ 43 (CCPA 1973). Thus, commercial interest can be construed as commercial success only if that interest generated is evidenced to stem from the commercial success directly derived from the invention claimed.

In the present case, the Applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. See *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996). The Affiant appears to be state at items 14 and 15 that the reason for commercial success was "our automation developments." However, claims 19, 31, and 33 do not appear to recite an "automated system or process".

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of non-obviousness fails to outweigh the evidence of obviousness.

Response to Arguments

10. Applicant's arguments with respect to claims 19-39 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

13. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]

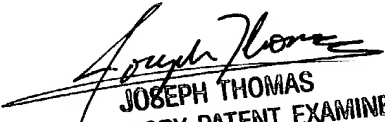
(703) 746-8374 [Informal/ Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th Floor (Receptionist).

CB

CB

July 29, 2004


JOSEPH THOMAS
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